



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,260	12/15/2003	Andre Reichmann	P/1281-118	5815

2352 7590 04/18/2005

OSTROLENK FABER GERB & SOFFEN  
1180 AVENUE OF THE AMERICAS  
NEW YORK, NY 100368403

EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/737,260

Applicant(s)

REICHMANN, ANDRE

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action acknowledges the applicant's Amendment submitted 21 January 2005. Claims 1-5 and 7-11 are pending in the application. Claim 6 has been canceled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

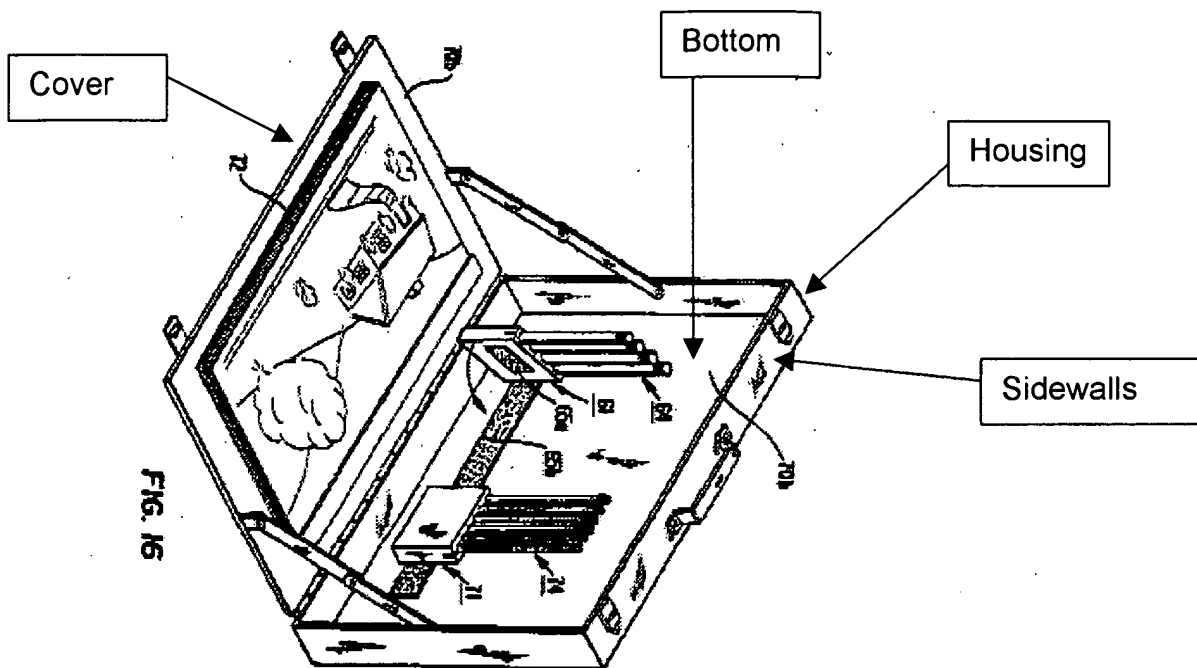
3. Claims 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7-10 depend either directly or in dependent chain to claim 6 (canceled).

To prosecute the examination of the claims, the examiner presumes claims 7 and 10 to depend from claim 1.

### ***Claim Rejections - 35 USC § 102***

4. Claims 1, 2, 7, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayduchok (US 5,163,549).



Regarding claim 1, Hayduchok discloses a marker holder assembly (see Figure 16) with a housing having an open top, four sidewalls, and a bottom wall fixed to one another (see above), and a tray **61** mounted entirely within the housing and having a plurality of openings (see Figures 1-4) into which a cap of a marker is securable by a snap fit (see for example, Col. 1, lines 48-53). Tray **61** is spaced a distance from the bottom wall by the thickness of fastening means **65b**. Hayduchok discloses markers **4a** with nibs **4c** and caps **4b**.

As to claim 2, Hayduchok discloses a hinged cover (portion onto which paper 72 is mounted).

As to claim 7, Hayduchok discloses a hinged cover (see above).

Art Unit: 3728

As to claim 8, Hayduchok discloses sidewalls with a height as claimed (see above).

As to claim 10, Hayduchok discloses tray **61** with four openings (see Figure 4).

***Claim Rejections - 35 USC § 103***

5. Claims 1-3, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayduchok (US 5,163,549) in view of Petit (US 5,630,508).

Regarding claims 1, 2, and 7, Hayduchok discloses a tray **1** with a plurality of openings **2** into each of which a cap **4b** of a marker **4a** (each having a nib **4c**) is securable by snap fit (see Figures 5-8). Hayduchok discloses the tray capable of transport in a pocket or purse (Col. 1, lines 14-20). Hayduchok also anticipates the placement of the tray within a separate container (see Figure 16). Tray **1** is a thin flat object (see Figure 1).

Petit discloses a housing **3** with a hinged closure **5** for holding thin, flat objects. The recognition of the need for protection of the markers when carried in a pocket or purse is within the knowledge generally available to one of ordinary skill in the art and easily discernable from Figure 1 of Hayduchok since the ends of the markers are exposed to the environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the individual tray of Hayduchok within the housing of Petit as suggested by Hayduchok in order to protect the markers when carried in the pocket or purse.

As to claim 3, Petit discloses detents **83 & 85**.

Art Unit: 3728

As to claim 10, Hayduchok discloses four openings (see Figure 4).

6. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayduchok-Petit as applied to claims 2 and 7 above, and further in view of Chouinard et al (US 2003/0111373 A1).

Hayduchok-Petit discloses the claimed invention except for the ridge member on the inner top surface of the cover.

Chouinard et al discloses ridge members **54** in the inner top surface of closure **28** used to contact the retained articles to ensure a positive retention of the articles (see paragraph [0023]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the assembly of Hayduchok-Petit with ridge members as taught by Chouinard et al in order to ensure a positive retention of the articles.

7. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayduchok-Petit as applied to claim 1 above, and further in view of Mander et al (US 3,643,812).

Hayduchok-Petit discloses the claimed invention except for the braces and lips for the retention of the tray.

Mander et al discloses a housing **10** with integral vertical braces **R** and lips **17** used to secure the tray **11** to housing **10** (see Col. 1, lines 41-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide

Art Unit: 3728

the housing of Hayduchok-Petit with integral braces and lips as taught by Mander et al in order to separably, yet firmly secure the tray to the housing.

### ***Double Patenting***

8. Applicant is advised that should claim 2 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Response to Arguments***

9. Applicant's amendment has overcome the rejection of claim 1 over Nakata et al (US 4,736,838). Applicant's arguments concerning Nakata et al are rendered moot.

10. Applicant's arguments filed 21 January 2005, with respect to the applicability of the Hayduchok reference, have been fully considered but they are not persuasive. As shown in the figure above, Hayduchok discloses the claimed structures and "reads on" claims 1, 2, 7, 8, and 10.

11. Applicant does not argue the merits of the combinations of Hayduchok-Petit, Hayduchok-Petit-Chouinard, or Hayduchok-Petit-Mander.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.




Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Pickett  
Examiner  
6 April 2005



Mickey Yu  
Supervisory Patent Examiner  
Group 3700